

REMARKS

I. Claim Rejections - 35 USC § 103

Requirements for *Prima Facie* Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

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It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

Komar in view of Kitsukawa and Ma

The Examiner rejected Claims 1-10 and 12-20 under 35 U.S.C. §103(a) as being unpatentable over Komar et al. (U.S. Patent Publication No. 2003/0079224), hereinafter referred to as "Komar", in view of Kitsukawa et al. (U.S. Patent No. 6,282,713), hereinafter referred to as "Kitsukawa" and further in view of Ma et al. (U.S. Patent No. 6,282,713), hereinafter referred to as "Ma".

Regarding claims 1 and 10, the Examiner argued that Komar discloses a method and system comprising: maintaining a searchable digital image database wherein said digital image database contains at least one data item comprising a digital image (citing Komar page 3, paragraph [0024]) (The Examiner argued that here a database is disclosed in which a 3d digital image can be retrieved. The Examiner argued that this discloses the capability to store images and search for an image since databases includes operations like searching. The Examiner argued therefore it would have been obvious and is of the ordinary capability of one skilled in the art to provide a searchable database for digital images.); associating at least one object with a data item of said at least one data item, wherein said at least one object contains information relevant to said data item and wherein said at least one object comprises an iconette (citing Komar page 2, paragraphs [0020]-[0021] and page 4, paragraph [0031]); and further wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only (citing Komar page 2, paragraph [0019]; and page 4, paragraph [0023]) (The Examiner argued that here in addition to being able to provide

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information about the product within the image it also can provide display area format data which deals with the actual image itself such as the bitmap information. The Examiner further argued that disclosed in Komar is the *functionality* to display both sources of information and one or the other as deemed for the selected area.); and displaying said data item in allocation of a display screen proximate to said at least one object, and wherein a selection of said at least one object invokes a display of said information relevant to said data item, wherein said data item is displayed simultaneously with said display of said information relevant to said data item (citing Komar page 2, paragraph [0016] and page 3, paragraph [0025]).

However, the Examiner admitted that Komar does not explicitly disclose a compacted view and that said compacted view of said data item is a compacted representation of said data item. However the Examiner argued that Kitsukawa discloses a method for providing on demand electronic advertising and further discloses a compacted view of an image (citing Kitsukawa FIG. 5 and col. 8, lines 57-67). Therefore, the Examiner argued that it would have been obvious to one having ordinary skill in the art at the time of the invention to include a compacted view of the image in Komar as taught by Kitsukawa. The Examiner argued that one would have been motivated to have the compacted view to show detailed images of possible selections such as unobstructed view with focus set on item only.

The Examiner further admitted that Komar does not disclose a *user* searches through the database. However, the Examiner argued that Ma has disclosed an image database that allows a user to search for a particular image (citing Ma abstract). The Examiner argued that therefore it would have been obvious to make the database on Komar a user searchable database as taught by Ma. The Examiner argued that one would have been motivated to allow the user to search the database because it would provide a direct and efficient query for known items of interest to the user.

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The Applicant respectfully disagrees with this assessment and notes that claims 1 and 10 have been amended to include the limitation of displaying a compacted view of said data item (i.e. "thumbnail view") in a location of a display screen within a frame containing said at least one object. There are a millions of images available on the internet; however, easily locating the copyright information, cost of the image, etc. is very difficult for a user. One of the Applicant's innovations is that the object or iconette is located within the frame around the thumbnail or compacted view of the image. Selection of the object within the frame displays the information about the image. This is disclosed in the Applicant's paragraph [0037]. Komar in view of Kitsukawa and further in view of Ma does not disclose this limitation.

The Examiner has argued that Komar discloses the limitation that the relevant information displayed is detailed information of the digital image *only*. First of all, Komar does not, in fact, disclose relevant information *displayed* which comprises detailed information about *the digital image*. This is shown in the Examiner's citation as Komar discloses utilizing *display area format data* 117. The Examiner has argued that this display area format data is displayed to the user; however, this is not disclosed as being *displayed* to the user in the Komar reference. Format data utilized by the system and not displayed (or even disclosed with the capability of being displayed) can not be considered to be detailed information *displayed*.

The Examiner admits that Komar does not disclose the limitation of displaying detailed information of the digital image only as the Examiner argues: "Here (the) *in addition* to being able to provide information about the product within the image *it can also provide* display area format data which deals with the actual image itself such as the bitmap information." The Examiner's own argument states that multiple types of information can be displayed; some information about the product and some information about the image. The Examiner states in one sentence that Komar discloses *only* detailed information about the image and yet in

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the next sentence argues that Komar discloses other information *in addition* to this information. Based on the Examiner's statement, this limitation of displayed detailed information of the digital image only from claim 1 is not anticipated by Komar.

Additionally, the Applicant points out to the Examiner that the claim 1 limitation is that the compacted view is a compacted view of the *data item* and not a *portion* of the data item as in the Komar reference (a portion of the full image). The Applicant notes that "compacted" means smaller in most definitions of the word; i.e. a "thumbnail" view of the image from the database. A compacted view of an image would be a smaller view of the *same* image. Furthermore, the Examiner has argued that Kitsukawa discloses a *compacted view of an image*, citing FIG. 5 and col. 8, lines 57-67. The Applicant notes that this citation in Kitsukawa does not disclose any information concerning a compacted view of an image. Kitsukawa only discloses advertizing information for items in the full image displayed; there is not a compacted view disclosed. The Applicant invites the Examiner to re-read the cited Kitsukawa reference and note this fact. Furthermore, a search of the entire Kitsukawa reference does not find any location wherein a "compacted image" or a "thumbnail image" is disclosed. Therefore, the Applicant submits Kitsukawa does not disclose this limitation.

The Examiner has combined the Komar and Kitsukawa references, arguing that the motivation to combine the references is to have the *compacted* view to show detailed images of possible selections such as unobstructed view with focus set on item only. This does not describe what a "compacted view" of an image is and the Applicant asks the Examiner how a *compacted* view of an item from an image can show detail not available in the full image. As a compacted view of an image *cannot* show greater detail than a full-sized image, the Applicant submits there would not be a motivation by one of ordinary skill in the art to combine the Komar and Kitsukawa references as cited by the Examiner.

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Therefore, Komar in view of Kitsukawa and further in view of Ma does not disclose 1) displaying relevant information about *the data item* wherein the data item comprises a digital image; 2) wherein said information relevant to said at least one data item comprises *detailed information* about said at least one digital image *only*; 3) displaying a compacted view of said data item in a location of a display screen, or 4) within a frame containing said at least one object.

Komar in view of Kitsukawa and further in view of Ma therefore fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's invention is not disclosed. Additionally, the Applicant submits that there would not be a motivation by one of ordinary skill in the art to combine the Komar and Kitsukawa references. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 1 and 10 based on the Komar, Kitsukawa and Ma references be withdrawn.

Regarding claims 2 and 12, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses automatically invoking display of information relevant to said data item in response to dragging a graphically displayed cursor across said at least one object displayed on said display screen (citing Komar, page 2, paragraph [0021] and page 4, paragraphs [0031] and [0032]).

Regarding claim 3, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claim 1 above and further discloses selecting said at least one object to invoke a display of information relevant to said data item (citing Komar, page 2, paragraph [0016]).

Regarding claims 4 and 14, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses information relevant to said data item in a form of graphical pop-up window, which when selected by user activates an additional graphical window comprising further information relevant to said data item (citing Komar, page 3, paragraph [0025] and page 4, paragraphs [0031] and [0032]).

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Regarding claims 5 and 15, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses information relevant to said data item in a form of graphical pop-up window, which when selected by user activates an additional graphical window comprising further information relevant to said data item as in claims 4 and 14 above and further discloses that the additional graphical window comprises an interactive region for initiating at least one user transaction thereof (citing Komar, page 2, paragraph [0016]).

Regarding claim 6 and 16, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses at least one object as a graphical iconette displayable on said display screen (citing Komar, page 2, paragraph [0016]; page 4, paragraph [0004] and page 31).

Regarding claims 7 and 17, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses that the item comprises a graphical image (Komar, page 2, paragraph [0017]; page 3, paragraph [0026]).

Regarding claims 8 and 18, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses displaying a compacted view of a plurality of data items in a display area of a display screen, wherein at least one data item among said plurality of data items is displayed proximate to at least one object containing information relevant to said at least one data item, wherein a selection of said at least one object invokes a display of information relevant to said at least one data item (citing Komar, page 2, paragraph [0016]; page 23, paragraph [0023]; and page 4, paragraph [0031]).

Regarding claim 9, the Examiner argued that Komar and Kitsukawa disclose a method as in claim 1 above and further discloses: a) displaying data associated with said data item as a graphical icon on said display screen (citing Komar, page 2, paragraphs [0016] and [0020]); and b) displaying said at least one object as a graphical iconette embedded within a graphical frame surrounding said graphical

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icon, wherein said graphical iconette can be invoked by said user to display information relevant to said graphical icon (citing Komar, page 4, paragraph [0031]).

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejections of claims 1 and 10 applies equally against the rejections of claims 2-9, 12 and 14-18 as these claims are dependent upon either claim 1 or 10. As submitted above, Komar in view of Kitsukawa fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's independent claims is not disclosed. Additionally, as submitted above, there would be not be a motivation to combine the Komar and Kitsukawa references as cited by the Examiner.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 2-9, 12 and 14-18 based on the Komar, Kitsukawa and Ma references be withdrawn.

Komar in view of Kitsukawa, Ma, Willner and Davis

The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Komar, Kitsukawa and Ma as applied in claim 10, and further in view of Willner et al. (U.S. Patent No. 7,149,370), hereinafter referred to as "Willner" and Davis et al. (U.S. Patent No. 7, 010,370), hereinafter referred to as "Davis".

Regarding claim 13, the Examiner argued that Komar, Kitsukawa and Ma disclose a method and system as in claim 10 above and further discloses selecting said at least one object to invoke a display of information relevant to said data item (citing Komar, page 2, paragraph [0016]). The Examiner admitted that the combination does not explicitly disclose wherein said object of information includes at least one of the following; copyrights, tile size, tile format, royalties file permissions and conditions of use.

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However, the Examiner argued that Willner discloses a method and device for image surfing and discloses providing additional information about image including file size (citing Willner col. 8, lines 24-31). The Examiner argued that Davis discloses associating image metadata with an image which includes copyright information and format (citing Davis col. 10, lines 24-29 and 50-51; and col. 11, lines 8-10). The Examiner argued therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to provide file information as relevant information in the modified Komar as taught by Willner and Davis. The Examiner argued that one would have been motivated to provide file information to inform user specific details which can enhance user's knowledge and inform them conditions.

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejections of claims 1 and 10 over Komar in view of Kitsukawa applies equally against the rejection of claim 13 as this claim is dependent upon claim 10.

Therefore the Applicant submits that Komar in view of Kitsukawa and Ma and further in view of Willner and Davis fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claim is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 13 based on the Komar, Kitsukawa, Ma, Willner and Davis references be withdrawn.

Komar in view of Kitsukawa, Ma and Gayraud

The Examiner rejected claim 20 under 35 U.S.C. §103(a) as being unpatentable over Komar, Kitsukawa, Ma and Gayraud et al. (U.S. Patent No. 5,436,637), hereinafter referred to as "Gayraud".

Regarding claim 20, the Examiner argued that Komar discloses a system comprising: maintaining a searchable digital image database wherein said digital image database contains at least one data item (citing Komar page 3, paragraph

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[0024]; the Examiner argued that here a database is disclosed in which a 3d digital image can be retrieved). The Examiner argued that therefore it would have been obvious and is of the ordinary capability of one skilled in the art to provide a searchable database for digital images; at least one iconette associated with a data item of said at least one data item wherein said at least one iconette contains information relevant to said to data item (citing Komar page 4, paragraph [0031]; the Examiner argued that once selected, the information about the item is available therefore an icon or iconette is associated with the item) and wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only (citing page 2, paragraph [0019]; page 3, paragraph [0023]). The Examiner argued that in addition to being able to provide information about the product within the image it also can provide display area format data which deals with the actual image itself such as the bitmap information. The Examiner argued that disclosed is the functionality to display both sources of information and one or the other as deemed for the selected area.

The Examiner argued that a display module for displaying a compacted view of said data item in a location of a display screen proximate to said at least one iconette, and wherein a selection of said at least one iconette invokes a display of information relevant to said data item and wherein said data item is displayed simultaneously with said display of said information relevant to said data item (citing page 3, paragraph [0025]; page 2, paragraphs [0016] and [0020]; page 4, paragraph [0031]).

The Examiner admitted that however Komar does not explicitly disclose a compacted view and that said compacted view of said data item is a compacted representation of said data item. The Examiner argued that however Kitsukawa discloses a method for providing on demand electronic advertising and further discloses a compacted view of an image (citing FIG. 5, col. 8, lines 57-67). The Examiner stated that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include a compacted view of t he

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image in Komar as taught by Kitsukawa. The Examiner argued that one would have been motivated to have the compacted view with focus set on item only.

The Examiner admitted that Komar also does not explicitly disclose wherein said display module displays data associated with said data item as a graphical icon on said display screen.

The Examiner argued that Gayraud discloses a graphical user interface system and methods for improved user feedback and further discloses hints of icons containing text or graphical messages of what an icon represents (citing col. 3, lines 45-59). The Examiner argued that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include hints of data about what the icon represented in Komar as taught by Gayraud. The Examiner argued that one would have been motivated to have hints about the icon to improve the user-friendly aspect of the application because it allows the user to view where the icon will guide the user.

The Examiner further admitted that Komar does not explicitly disclose a user searches through the database. The Examiner argues that Ma discloses an image database that allows a user to search for a particular image. The Examiner Argues therefore it would have been obvious to make the database in Komar a user searchable database as taught by Ma and that one would have been motivated to allow the user to search the database because it would provide a direct and efficient query for known items of interest to the user.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejections of claims 1 and 10 applies equally against the rejection of claim 20. The Applicant further notes that claim 20 has been amended similar to claims 1 and 10 wherein the digital image is within a frame containing said at least one iconette. As submitted above, Komar in view of Kitsukawa and Ma fails to disclose: 1) displaying relevant information about *the data item* wherein the data item comprises a digital image; 2) wherein said information relevant to said at least one data item comprises *detailed information*

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about said at least one digital image *only*; 3) displaying a *compacted* view of said data item, or 4) in a location of a display screen within a frame containing said at least one object.

Gayraud does not disclose the above limitations. Therefore, Komar in view of Kitsukawa, Ma and Gayraud fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claim is not disclosed.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 20 based on the Komar, Kitsukawa, Ma and Gayraud references be withdrawn.

Komar in view of Kitsukawa, Ma, Gayraud, Willner and Davis

The Examiner rejected claim 21 under 35 U.S.C. §103(a) as being unpatentable over Komar, Kitsukawa, Ma and Gayraud as applied in claim 20 and further in view of Willner and Davis.

Regarding claim 21, the Examiner argued that Komar, Kitsukawa, Ma and Gayraud disclose a method and system as in claim 20 above and further discloses a selection module for selecting said at least one iconette to invoke said display of information relevant to said data item (citing Komar, page 2, paragraph [0016]). However, the Examiner admitted that Komar, Kitsukawa, Ma and Gayraud do not explicitly disclose wherein said object of information includes copyrights at least one of the following; file size, file format, royalties file permissions and conditions of use. However, the Examiner argued that Willner discloses a method and device for image surfing and discloses providing additional information about image including file size (citing Willner col. 8, lines 24-31). The Examiner argued that Davis discloses associating image metadata with an image which includes copyright information and format (citing Davis col. 10, lines 24-29 and 50-51; col. 11, lines 8-10). The Examiner argued that it would have been obvious to one having ordinary skill in the art at the time of the invention to provide file information as relevant information in the modified Komar as taught by Willner and Davis. the

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Examiner argued one would have been motivated to provide file information to inform the user of specific details which can enhance the user's knowledge and inform them of conditions.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejections of claims 1, 10, 13 and 20 applies equally against the rejection of dependent claim 21.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 21 based on the Komar, Kitsukawa, Gayraud, Ma, Willner and Davis references be withdrawn.

II. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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